

PTO Form 1957 (Rev 9/05)

OMB No. 0651-0050 (Exp. 04/2009)

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	76639475
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 113
<b>MARK SECTION (current)</b>	
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
LITERAL ELEMENT	ASHLEY B BERNARDO
<b>MARK SECTION (proposed)</b>	
MARK FILE NAME	\\TICRS2\EXPORT12\766\394\76639475\xml1 \\ROA0002.JP G
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
LITERAL ELEMENT	ASHLEY B BERNARDO
COLOR MARK	NO
PIXEL COUNT ACCEPTABLE	YES
PIXEL COUNT	435 x 336
<b>ARGUMENT(S)</b>	
<p style="text-align: center;"><b><u>REQUEST FOR RECONSIDERATION</u></b></p> <p>This submission is in response to the Final Office Action (Office Action No. 2) mailed July 17, 2006 with respect to the above-captioned mark. Simultaneously herewith, the Applicant has filed a Notice of Appeal with the Trademark Trial and Appeal Board.</p> <p style="text-align: center;"><b><u>DRAWING</u></b></p> <p>The Examining Attorney has requested that Applicant submit a new drawing showing the entire mark</p>	

clearly, without the federal registration symbol ("®") included in the initial drawing submitted. Applicant submits the attached drawing, which meets the aforementioned requirements.

### **REFUSAL TO REGISTER**

Applicant seeks to register the mark ASHLEY B BERNARDO for "[c]lothing; namely swim wear, hats, belts, ties, scarves, dresses, sweaters, suits, pants, jeans, vests, tops, shirts, shorts, blazers and skorts; outerwear, namely jackets, coats, vests, raincoats, and wind-resistant jackets" in International Class 25. The Examining Attorney has refused registration on the ground that Applicant's ASHLEY B BERNARDO mark so closely resembles Registration No. 1,582,474 for the mark ASHLEY B for "jewelry, namely, earrings, necklaces, bracelets" (hereinafter, the "Jewelry Mark") that it is likely to cause confusion or mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. 1052(d). Applicant asks the Examining Attorney to take note of all prior-filed arguments and prior case law submitted by Applicant in the response filed against this Section 2(d) refusal to date. Applicant hereby submits new evidence and arguments for the purpose of this Request for Reconsideration.

### **ARGUMENT**

#### **I. The Marks At Issue Are Distinguishable**

Applicant's mark is not likely to cause confusion with the Jewelry Mark under Section 2(d) of the Trademark Act. The test for likelihood of confusion under Section 2(d) is "whether the purchasing public would mistakenly assume that the applicant's goods or services originate with, are sponsored by, or are in some way associated with the goods sold under the cited registration." 3 J. Thomas McCarthy, McCarthy On Trademarks and Unfair Competition § 23:78 (citing *FBI v. Societe: "M.Brill & Co."*, 172 U.S.P.Q. 310 (T.T.A.B. 1971)).

#### **A. The Marks Must Be Considered And Compared In Their Entirety**

The basic rule provides that the marks at issue "must be considered [and compared] in their *entireties* in determining whether there is likelihood of confusion or mistake." *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402 (C.C.P.A. 1974) (emphasis added) (finding the Board to have mistakenly dissected the letters "F.I.A." from the applicant's mark as a whole, and using that dissected portion to compare the marks at issue); *see also Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30 (Fed. Cir. 2000) ("The similarity or dissimilarity of the marks in their entirety is to be

considered with respect to appearance, sound, and connotation.”) (citing *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973); *Old Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 202–03 (Fed. Cir. 1992); *In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985)).

**B. The Marks At Issue Are Visually And Aurally Distinguishable**

Each case must be decided on its own facts and circumstances, including “the nature and impact of the marks.” *In re British Bulldog, Ltd.*, 224 U.S.P.Q. at 856 (quoting *In re Sydel Lingerie*, 197 U.S.P.Q. at 630). As discussed above, all elements of the mark in question must be considered, and additional and “plainly visible” design and word elements may be “sufficiently conspicuous” to distinguish between two marks. *Massey Junior Coll., Inc.*, 492 F.2d at 1404–05 (rejecting contention that the other elements of the mark in question were “not sufficiently conspicuous” to distinguish “FIA” from “FIT,” and noting that the additional design element and the additional language “FASHION INSTITUTE OF AMERICA” were “plainly visible” and sufficient “to provide distinctive meaning to any commercial impression which might be created by the letters ‘FIA’”); *see also Recot, Inc.*, 214 F.3d at 1329–30 (remanding where the Board did not consider the appearance or overall sound of the marks).

The use of an identical word, even a dominant word, does not mean that two marks are likely to be confused. *See Freedom Savings & Loan Ass'n v. Way*, 757 F.2d 1176, 1182 (11th Cir. 1985); *Alltel Corp. v. Actel Integrated Communications, Inc.*, 42 F. Supp. 2d 1265, 1270 (S.D. Ala. 1999). The ASHLEY B BERNARDO Mark, when considered in its entirety, creates a commercial impression distinct from the Jewelry Mark. As shown in the comparison below, the ASHLEY B BERNARDO Mark is a logo and not a word mark, which distinguishes the marks visually.

ASHLEY B BERNARDO MARK	JEWELRY MARK
See resubmitted drawing	ASHLEY B.

Moreover, the inclusion of the additional word “BERNARDO” in the ASHLEY B BERNARDO Mark, also distinguishes it from the Jewelry Mark both visually and aurally, which only uses “ASHLEY B,” with the addition of a period at the end of “B,” something the ASHLEY B BERNARDO Mark does not contain.

The BERNARDO mark, which is the subject of Registration Numbers 2,978,052, 2,911,578, 2,433,856, and 1,979,147, is a very well established mark, being in use with the goods at issue since 1988. The fact that the BERNARDO mark is included in all capital letters, and set out boldly in white

type against a black background directly beneath the "ASHLEY B" portion of the ASHLEY B BERNARDO Mark creates an overall impression that is considerably different from the Jewelry Mark. Additionally, the use of different typeface for the "ASHLEY B" portion – with "ashley" in all lower-case letters and followed by a capital "B" – creates a distinguishable stylistic impression from the Jewelry Mark. Finally, the use of shaded and unshaded rectangles in the ASHLEY B BERNARDO Mark also serve to create a distinct commercial impression from that created by the Jewelry Mark. All of these features are plainly visible and should be considered sufficiently conspicuous to distinguish the ASHLEY B BERNARDO Mark from the Jewelry Mark. In short, the inclusion of the well-known BERNARDO mark and the rectangular design, as well as the stylization of the "ASHLEY B" portion of the mark, on the goods bearing the ASHLEY B BERNARDO Mark creates a unique commercial impression and eliminates any possibility that consumers will be confused as to the source of the goods. *See W.W.W. Pharm. Co. v. Gillette Co.*, 984 F.2d 567, 573 (2d Cir. 1993) (holding that SPORT STICK was not confusingly similar to SPORTSTICK because of the use of defendant's brand name next to the SPORT STICK mark); *Meija & Assocs. v. Int'l Business Machs.*, 920 F. Supp. 540, 547 (S.D.N.Y. 1996) (where both parties used the mark EDUQUEST, stating that "[o]ne factor that heavily undercuts the contention that the marks are confusingly similar is that defendant consistently uses the word 'IBM' as an identifier in a tagline or conspicuously nearby").

## **II. No Actual Confusion**

Another *DuPont* factor is the nature and extent of any actual confusion. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d at 1361. To our knowledge, there has been no actual confusion between the ASHLEY B BERNARDO Mark and the Jewelry Mark.

## **III. Request For Suspension Of Action By Trademark Office**

Counsel for Applicant searched for instances of use of the Jewelry Mark in connection with "jewelry, namely, earrings, necklaces, bracelets," but has been unable to find such evidence of use. Counsel for Applicant then contacted counsel for the owner of the Jewelry Mark ("Jewelry Mark Counsel") to ascertain present use of the Jewelry Mark in connection with such goods, but have not yet received a response. In order to give Jewelry Mark Counsel time to respond to Applicant's inquiries, Applicant respectfully requests that the Examining Attorney issue a three month suspension in connection with this application for the ASHLEY B BERNARDO Mark in which to confirm discontinuation of use of the Jewelry Mark, petition for cancellation of the Jewelry Mark, or otherwise resolve any dispute between the parties.

## **CONCLUSION**

Based upon the foregoing, Applicant submits that the ASHLEY B BERNARDO Mark is entitled to registration on the Principal Register and should be passed to publication.

**SIGNATURE SECTION**

RESPONSE SIGNATURE	/Jonathan Moskin/
SIGNATORY'S NAME	Jonathan Moskin
SIGNATORY'S POSITION	Attorney
DATE SIGNED	01/17/2007
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Wed Jan 17 18:41:58 EST 2007
TEAS STAMP	USPTO/ROA-38.112.184.20-2 0070117184158510021-76639 475-3609cd7af8ab5e8bc6bfc 2cdad86bbf0e0-N/A-N/A-200 70117183026309352

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OMB No. 0651-0050 (Exp. 04/2009)

### Response to Office Action

#### To the Commissioner for Trademarks:

Application serial no. **76639475** has been amended as follows:

#### Mark

Applicant proposes to amend the mark as follows:

Original: ASHLEY B BERNARDO (Stylized and/or with Design)

Proposed: ASHLEY B BERNARDO (Stylized and/or with Design, see mark)

The applicant is not claiming color as a feature of the mark.

#### Argument(s)

In response to the substantive refusal(s), please note the following:

#### REQUEST FOR RECONSIDERATION

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#### DRAWING

The Examining Attorney has requested that Applicant submit a new drawing showing the entire mark clearly, without the federal registration symbol ("®") included in the initial drawing submitted.

Applicant submits the attached drawing, which meets the aforementioned requirements.

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### **Response Signature**

Signature: /Jonathan Moskin/ Date: 01/17/2007

Signatory's Name: Jonathan Moskin

Signatory's Position: Attorney

Serial Number: 76639475

Internet Transmission Date: Wed Jan 17 18:41:58 EST 2007



TEAS Stamp: USPTO/ROA-38.112.184.20-2007011718415851  
0021-76639475-3609cd7af8ab5e8bc6bfc2cdad  
86bbf0e0-N/A-N/A-20070117183026309352

a s h l e y B

BERNARDO